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6715/57089

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Han Min-Jae
Serial No.: 09/319,093
Filed: May 28, 1999
For: RECORD/PLAYBACK APPARATUS AND RECORD/PLAYBACK METHOD

National Stage Processing

I hereby certify that this paper is being deposited this date with the U.S. Postal Service as first class mail addressed to :
Assistant Commissioner for Patents, BOX PCT,
Washington, D.C. 20231

JAY H. MAIOLI
Reg. No. 27,213

Jay H. Maioli
Date 9.30.99

September 30, 1999
1185 Avenue of the Americas
New York, NY 10036
(212) 278-0400

RESPONSE TO NOTIFICATION OF A DEFECTIVE RESPONSE

Assistant Commissioner for Patents
Box PCT
Washington, D.C. 20231

Sir:

In the Notification of a Defective Response dated September 2, 1999, a copy of which is attached hereto as Exhibit A, it was stated that the application fails to contain an oath or declaration acceptable under 35 U.S.C. 371(c)(4) for entry into the national stage. It was also stated that a new oath or declaration, identifying this application by the international application number and international filing date is required. The declaration filed August 16, 1999 allegedly does not comply with 37 CFR 1.497(a) and (b) in that it does not state that "the

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Legal Staff
International Division

person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought." Specifically, the inventor's name Han Min-Jae is not listed as an inventor on the published application.

Applicant acknowledges that the name "Han Min-Jae" is not listed on the published application. Rather, the name "Kan Toshiya" is listed thereon. In actuality, however, "Han Min-Jae" and "Kan Toshiya" are the same person. This discrepancy occurred because the person who translated the Japanese Application into the English language believed the inventor's name should be translated as "Kan Toshiya" when, in fact, the proper pronunciation and spelling of the inventor's name is "Han Min-Jae."

The inventor's name could be read differently when translating from Korean to Japanese to English, and this U.S. application is based on reading the inventor's name in Korean. Therefore, the inventor of this U.S. Application is the same person as the inventor of the PCT Application.

Because "Han Min-Jae" is the inventor of this U.S. Application and is the same person as the inventor of the PCT Application, it is submitted that the declaration filed on August 16, 1999, in response to Notice of Missing Requirements mailed July 8, 1999, is not defective and properly states that Han Min-Jae believes himself to be the original, first and sole inventor of the subject matter which is claimed and for which a patent is sought. For this reason, it is submitted that a new declaration


is not required because the declaration filed on August 16, 1999 is in fact accurate.

Also attached hereto as Exhibit B is a STATEMENT OF TRANSLATION OF INVENTOR'S NAME, signed by the official translator in this case, and explaining the name discrepancy. It is believed that this Response in addition to the attached Statement is sufficient to overcome the Notification of a Defective Oath or Declaration.

Favorable reconsideration is earnestly solicited.

Respectfully submitted,

COOPER & DUNHAM LLP

A handwritten signature in dark ink, appearing to read "Jay H. Maioli", written in a cursive style.

Jay H. Maioli
Reg. No. 27, 213

JHM/RAD



Patent and Trademark Office

Box PCT

Washington, D.C. 20231

09/319,093
U.S. APPLICATION NO.

U.S. APPLICATION NO.

FIRST NAMED APPLICANT

6715/57089
ATTY. DOCKET NO.

JAY H MAIOLI
COOPER & DUNHAM
1185 AVENUE OF THE AMERICAS
NEW YORK NY 10036

5611

~~PCT/JP98/04344~~
INTERNATIONAL APPLICATION NO.

I.A. FILING DATE -

PRIORITY DATE

09/02/99

DATE MAILED:

1. ☐ The request for an extension of time (37 CFR 1.136(a)) filed _____ is defective because the required fee is missing/insufficient. Extension of time fees are listed at 37 CFR 1.17(a)(1)-(a)(5).

2. ☐ Applicant's response filed _____ was received in the Office on _____ which is after the expiration of the period for response set in the last Office notification mailed _____. This application will become abandoned unless applicant obtains an extension of time to reply to the last Office notification under 37 CFR 1.136(a).

3. ☒ Applicant's response filed 16 AUG 1999 included the following items, the receipt of which is hereby acknowledged:

☐ Copy of the international application in:

☐ a non-English language.

☐ English.

☐ Translation of the international application into English ☐ which is defective for the reasons indicated on the attached Notice of Defective Translation.

☐ Processing fee (37 CFR 1.492(f)) ☐ which is insufficient.

☒ Oath or Declaration of inventor(s).

☐ in compliance with 37 CFR 1.497(a) and (b).

☒ not in compliance with 37 CFR 1.497(a) and (b) for the reasons indicated on the attached PCT/DO/EO/917.

☐ Surcharge (37 CFR 1.492(e)) ☐ which is insufficient.

☐ Copy of Article 19 amendments.

☐ Translation of Article 19 amendments into English.

☐ The International Preliminary Examination Report in English and its Annexes, if any.

☐ Translation of Annexes to the International Preliminary Examination Report into English.

☐ Preliminary amendment(s).

Information Disclosure Statement(s).

Assignment document.

☐ **Power of Attorney and/or Change of Address.**

Substitute specification.

☐ **Statement Claiming Small Entity Status.**

☐ Priority Document.

Other:

4. ☒ All of the requirements set forth in the notification of MISSING REQUIREMENTS (Form PCT/DO/EO/905 mailed 08 JUL 1999 have not been completed. 10/2/99

Applicant is required to complete the response within a time limit of ONE MONTH from the date of this Notification or within the time remaining in the response set forth in the Notification of Missing Requirements (Form DO/EO/905), whichever is the longer. No extension of this time limit may be granted under 37 C.F.R. § 1.136, but the period for response set in the Notification of Missing Requirements may be extended up to a maximum of six months.

Applicant is reminded that any communication to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above. (37 CFR 1.5)

Enclosed: ☒ PCT/DO/EO/917 ☐ Notice of Defective Translation

Pauline Kidwell, Paratoga
Telephone: (703) 305-3055

9/31/03



UNITED STATES PATENT AND TRADEMARK OFFICE
 Address: ASSISTANT COMMISSIONER FOR PATENTS
 Washington, D.C. 20231

U.S. APPLICATION NO. 67/519,093	FIRST NAMED APPLICANT KAN	ATTY. DOCKET NO. 671575/089
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INTERNATIONAL APPLICATION NO. PCT/JP98/04344

I.A. FILING DATE 09/28/98	PRIORITY DATE 10/02/97 09/02/99
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JAY H MAIOLI
 COOPER & DUNHAM
 1185 AVENUE OF THE AMERICAS
 NEW YORK NY 10036

5611

DATE MAILED:

NOTIFICATION OF A DEFECTIVE OATH OR DECLARATION

This application fails to contain an oath or declaration acceptable under 35 U.S.C. 371 (c)(4) for entry into the national stage in the United States of America. The period within which to correct these requirements and avoid abandonment is set in the accompanying Office action.

A new oath or declaration, identifying this application by the international application number and international filing date is required. The oath or declaration does not comply with 37 CFR 1.497(a) and (b) in that it:

1. ☐ is not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68.
 2. ☐ does not identify the specification to which it is directed.
 3. ☐ does not identify the inventor(s).
 4. ☐ does not identify the citizenship of each inventor.
 5. ☒ does not state the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought. *Kan, Min-Jae is not listed as a inventor on the published application*
- FAILURE TO SUBMIT AN OATH OR DECLARATION IN COMPLIANCE WITH 37 CFR 1.497(a) AND (b) WITHIN THE TIME PERIOD SET WILL RESULT IN FAILURE TO ENTER THE NATIONAL STAGE AND THE ABANDONMENT OF THE APPLICATION.

Additionally, the oath or declaration does not comply with 37 CFR 1.63 in that it:

1. ☐ does not identify the city and state or city and foreign country of residence or each inventor.
2. ☐ does not state that the person making the oath or declaration:
 - a. ☐ has reviewed and understands the contents of the specification, including the claims, as amended by any amendment specifically referred to in the oath or declaration.
 - b. ☐ acknowledges the duty to disclose information which is material to patentability as defined in 37 CFR 1.56.
3. ☐ does not identify the foreign application for patent or inventor's certificate on which priority is claimed pursuant to 37 CFR 1.55, and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application serial number, country, day, month, and year of its filing.
4. ☐ does not state that the person making the oath or declaration acknowledges the duty to disclose information which is material to patentability as defined in 37 CFR 1.56 which became available between the filing date of the prior application and filing date of the continuation in part application which discloses and claims subject matter in addition to that disclosed in the prior application (37 CFR 1.63(b)).

Paula K. Kidwell, Paralegal
 Telephone: (703)-305-3656

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Han Min-Jae
Serial No.: 09/319,093
Filed: May 28, 1999
For: RECORD/PLAYBACK APPARATUS AND RECORD/PLAYBACK
METHOD

August 31, 1999
1185 Avenue of the Americas
New York, NY 10036
(212) 278-0400

STATEMENT OF TRANSLATION OF INVENTOR'S NAME

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

I, Kouchi Takasaki, am an official translator of the Japanese language and I hereby certify that I translated into the English language Japanese Application No. 9-270164, filed October 2, 1997. At the time I translated the above Application from Japanese to English, I thought the inventor's name translated into "Kan Toshiya". I now am informed that the proper pronunciation and spelling of the inventor's name is "Han Min-Jae". The inventor's name could be read differently when translating from Korean to Japanese to English, and this U.S. application is based on reading the inventor's name in Korean. Therefore, the inventor of this U.S. Application is the same

person as the inventor of the PCT Application.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with knowledge that willful false statements and the like so made are punishable by fine or imprisonment or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Respectfully submitted,

Kouchi Takasaki
Kouchi Takasaki